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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/702,751	11/01/2000	Robert Klaus	114293-1601	9942

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EXAMINER

ST CYR, DANIEL

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 08/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/702,751

Applicant(s)

KLAUS ET AL.

Examiner

Daniel St.Cyr

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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DETAILED ACTION

1. Receipt is acknowledged of the amendment filed 5/28/03.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-4, 10, and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Arjomand, US Patent No. 5,884,202, cited by the applicant.

Arjomand discloses a modular wireless diagnostic test and information system comprising: a combined user interface and main control 12; a microprocessor (PC) for executing an operating system (windows base system) and a diagnostic application program; one internal non-volatile storage device, such as ROM, is inherently coupled to microprocessor and an external non-volatile memory (PCMCIA) card; the user interface configured for remote updating (through LAN connection) of at least one of a diagnostic application program and memory of the tool, wherein the said microprocessor, non-volatile storage device, and user interface are integrally connected to said diagnostic tool (see figures 1, 2; col. 5, line 26 to col. 6, line 31).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 4-9, 11-20, and 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arjomand. The teachings of Arjomand have been discussed above.

Arjomand fails to disclose or fairly suggest all the specific method steps, such as displaying the upgrading procedure, and some other details of the claimed invention, such as having the remote terminal connected to the Internet. However, these specific details fall within the realm of engineering design choice for meeting customers' expectation and specification, failing to provide any unexpected results. Furthermore, these steps and details are well known in the art. It would have been obvious for an artisan at the time the invention was made to modify the system of Arjomand to perform similar functions as the claimed invention. Regarding the specific method steps, since the structural limitations are as recited, the method steps is obtained. Therefore, it would have been an obvious extension as taught by Arjomand.

Response to Arguments

7. Applicant's arguments filed 5/28/03 have been fully considered but they are not persuasive. (see below).

REMARKS:

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In response to the applicant's first argument that Arjomand does not teach a user interface having at least one integrally connected communication port configured for remote updating of at least one diagnosis application program, the examiner respectfully disagrees. The user interface 52 includes integral communication port configured for remote updating of an application program, wherein the application program can be updated using flash reprogramming (see col. 15, line 62 to col. 16, line 10).

In response to the applicant's second argument and request to elaborate on the rejection under 35 U.S.C. 103(a), the examiner position is as follows:

a) displaying upgrade procedure, Arjomand discloses downloading application information into the user interface. Even though the specific steps are not explicitly disclosed, since the limitations are as recited, the specific step for the download is obtained and therefore, obvious. Furthermore, the specific step falls within the engineering design choice, which fails to provide any unexpected results, therefore, obvious.

b) determining whether a valid smart card is present, Arjomand discloses using a floppy disk drive or CD-ROM drive, detecting the presence of a disk or a CD would have been an obvious step when computer operated systems are used. Re the type of disk, such as smart disk/card, falls within the engineering design choice for meeting specific requirements. For instance, the choice is to decide whether the disk has some processing capability or not, both type of disk/card are available in the art.

c) providing user notification of the requested upgrade, such limitation is an obvious step for communication to an operator for operating a computing device, which an ordinary artisan would have found to be obvious. For instance, an operator is getting ready to do test and the

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device is in the process of receiving an application from a central location, it would have been obvious to put the operator on alert and notify the operator when the system is ready.

The applicant arguments are not persuasive. Refer to the rejection above.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

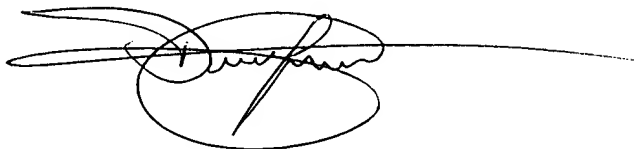
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel St.Cyr whose telephone number is 703-305-2656. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G Lee can be reached on 703-305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7721 for regular communications and 703-308-7724 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

Daniel St.Cyr
Primary Examiner
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A handwritten signature in black ink, appearing to read 'Daniel St. Cyr', is written over a horizontal line. The signature is stylized with a large, circular loop at the end.

DS
August 8, 2003